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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,828	06/23/2003	Guo Rui Deng	2451.PCRA.PT	9067

26986 7590 09/30/2004

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EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,828

Applicant(s)

DENG ET AL.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 2-4, 6-15, drawn to a die cutting apparatus with a specific base portion/blade configuration, classified in class 83.
 - II. Claims 1 and 5, drawn to a die cutting apparatus with plating, classified in class 83.
 - III. Claims 1 and 16-19, drawn to a die cutting apparatus with a covering, classified in class 83.
 - IV. Claims 20 and 21-25, drawn to method of forming a die cutting apparatus with specific forming steps, classified in class 76.
 - V. Claims 20 and 26, drawn to a method of forming a die cutting apparatus with a plating step, classified in class 76.
 - VI. Claims 20 and 27-30, drawn to a method of forming a die cutting apparatus with covering steps, classified in class 76.
 - VII. Claims 20 and 31, drawn to a method of forming a die cutting apparatus with a release pad forming step, classified in class 76.
2. Claims 1-19 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g., the base portion/blade configuration of Group I). It is noted that if claim 1 as originally filed is part of an elected group and determined to be patentable, rejoinder of claims 1-19 will be considered. It is

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further noted that claim 1 is listed as part of Groups I-III but is not considered to be part of any of these groups. Rather, claim 1 is a linking claim that recites subject matter that is common to all of the groups and has been shown as part of each group for clarity (i.e., so that it is clear which claims are part of each group). Further, because claim 1 includes subject matter that is common to all of the groups, it is not considered to be independent or distinct from any of the groups. Therefore, claim 1 will be examined upon election of one of groups I-III. The same applies to claim 20 with respect to the claims dependent therefrom.

3. The inventions are distinct, each from the other because of the following reasons:

Process-Apparatus Groups

4. Inventions IV-VII are related to inventions I-III as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process.

Apparatus Subcombinations

5. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group I has

separate utility such as without the plating of Group II. Conversely, the invention of Group II has separate utility such as without the specific base portion/blade configuration of Group I. See MPEP § 806.05(d).

6. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group I has separate utility such as without the covering of Group III. Conversely, the invention of Group III has separate utility such as without the specific base portion/blade configuration of Group I. See MPEP § 806.05(d).

7. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group II has separate utility such as without the covering of Group III. Conversely, the invention of Group III has separate utility such as without the plating of Group II. See MPEP § 806.05(d).

Method Subcombinations

8. Inventions IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group IV has separate utility such as without the plating step of Group V. Conversely, the invention of

Group V has separate utility such as without the specific base portion/blade configuration forming steps of Group IV. See MPEP § 806.05(d).

9. Inventions IV and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group IV has separate utility such as without the covering steps of Group VI. Conversely, the invention of Group VI has separate utility such as without the specific base portion/blade configuration forming steps of Group IV. See MPEP § 806.05(d).

10. Inventions IV and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group IV has separate utility such as without the release pad forming step of Group VII. Conversely, the invention of Group VII has separate utility such as without the specific base portion/blade configuration forming steps of Group IV. See MPEP § 806.05(d).

11. Inventions V and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group V has separate utility such as without the covering steps of Group VI. Conversely, the invention of Group VI has separate utility such as without the plating step of Group V. See MPEP § 806.05(d).

12. Inventions V and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if

they are shown to be separately usable. In the instant case, the invention of Group V has separate utility such as without the release pad forming step of Group VII.

Conversely, the invention of Group VII has separate utility such as without the plating steps of Group V. See MPEP § 806.05(d).

13. Inventions VI and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group VI has separate utility such as without the release pad forming step of Group VII. Conversely, the invention of Group VII has separate utility such as without the covering steps of Group VI. See MPEP § 806.05(d).

14. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Species Election

15. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A - Figures 1A-B;

Species B - Figs 2A-B;

Species C - Figure 5.

Upon election of one of the Groups of inventions, applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claims 1 and 20 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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16. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (703)308-1404. The examiner can be reached Monday through Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (703)308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', with a long horizontal stroke extending to the right.

Clark F. Dexter
Primary Examiner
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cf
September 24, 2004